

REMARKS

Claims 13, 18-24, 31, 34 and 40 are pending in this application. Reconsideration and withdrawal of the rejections of the application, entry of the Amendment filed December 19, 2007, and withdrawal of finality of the September 19, 2007 Office Action are respectfully requested in view of the remarks presented herein, which place the application into condition for allowance, or at least into better condition for appeal.

Claims 13, 18-24, 31, 34, and 40 were rejected under the first paragraph of Section 112 as allegedly lacking enablement in the final Office Action of September 19, 2007. The Office Action conceded that the specification was enabling “for a method of transducing a target mammalian adipose tissue cell *in vitro* with a lentiviral vector pseudotyped with the VSV-G protein and comprising at least one nucleotide sequence of interest.” Solely to advance prosecution, in the Amendment After Final Action under 37 C.F.R. § 1.116 (hereinafter “the Amendment”) filed on December 19, 2007, Applicants amended the claims to recite a “method of transducing a target mammalian adipose tissue cell *in vitro*,” which reflected the scope deemed enabled by the Examiner. The Advisory Action of January 18, 2008 indicated that the amendment to recite an *in vitro* method – if entered – would have overcome the Section 112 rejection. However, the Examiner contends that the change of scope to *in vitro* would necessitate a further search of the art.

In response, Applicants respectfully disagree and request that finality be withdrawn, as the need to conduct an additional search is not due to the claim amendments. Indeed, the scope of the claimed invention is not broadened as a result of the Amendment; the invention prior to the Amendment encompassed embodiments for both *in vivo* and *in vitro* methods, and in the Amendment, the scope of the invention was therein clarified to *in vitro* methods.

With this in mind, Applicants respectfully assert that a proper search and examination of the claims prior to the Amendment should have covered the full scope of the claims, i.e., both *in vivo* and *in vitro* methods. MPEP Section 904 states:

The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed,

including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.

Applied to the instant case, the first search, or even any subsequent searches, should have covered both *in vivo* and *in vitro* methods, since these methods are both within the scope of the invention that was originally described and claimed. Indeed, the Examiner recognized that the claims encompassed *in vitro* methods at the time the September 19, 2007 Office Action was issued, as evidenced by the reference to *in vitro* methods as being enabled.

Consequently, the instant claims directed to *in vitro* methods should not require a new search, as this embodiment should have been covered in the Examiner's previous searches. If a new search is nonetheless required, this is not the fault of Applicants, and Applicants should not be compelled and burdened to file a Request for Continued Examination (RCE) in order to have the instant claims properly examined. Thus, Applicants respectfully request that finality of the present application be withdrawn so that a proper search and examination can be performed.

To the extent that a petition is necessary for consideration and entry of this paper, it is respectfully requested that this paper serve as such Petition. Any fee occasioned by this paper, or for this paper serving as a Petition, or any overpayment in fees, may be charged or credited to Deposit Account No. 50-0320.

Respectfully submitted,

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